

Remarks

Claims 1, 4, 6, 8-12, 48-51, and 53-60 are pending. By this Amendment, claims 4, 53, and 54 are canceled, claims 1, 48, and 56 are amended, and new claims 61 and 62 are added. Following entry of this Amendment, there will be nineteen (19) pending claims, of which five (5) are independent (claims 1, 48, 56, 61, and 62). No new matter will be incorporated into the present application by entry of this Amendment. The Office is authorized and requested to charge Deposit Account No. 061910 for additional fees are deemed to be necessary with the filing of this Amendment.

Applicant's representatives thank Examiner Phi D A for extending them the courtesy of a personal interview on June 10, 2004 to discuss this case. The present Amendment is provided as a recordation of the substance of the interview in accordance with MPEP 713.04.

In the Office Action mailed February 25, 2004, the Examiner rejected claims 48-51 and 53 under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (5735089) in view of Berg (2874423); rejected claims 1, 4, 6, and 12 under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Eckert (3937949); rejected claims 8-11 under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. in view of Eckert and further in view of Smith et al (5735089); rejected claims 48-51, 53, and 55 under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. in view of Smith et al. and Emmanuel (58536119); rejected claim 54 under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. in view of Smith et al. and Emmanuel and further in view of Tachauer et al. (US2003/0070391). Applicant respectfully traverses, and requests reconsideration of, each of these rejections.

The Office Action rejected claims 1, 4, 6, and 12 under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Eckert (3937949). These claims involve a transparent window pane carrying a protective covering comprising a plurality of masking strips applied in a particular manner. In more detail, amended claim 1 recites "...the transparent pane having a removable protective covering comprising a plurality of strips of masking material that are disposed over a central portion of said first surface and that extend across a length of said first surface or across a width of said first surface...". Amended claim 1 also recites "...wherein said plurality of sequentially overlapped strips of masking material are each adhered to said first major surface by a masking adhesive...". None of these features would be achieved by any combination of Adams Jr. and Eckert, assuming arguendo that a prima facie case of obviousness exists. Consider the following.

Adams Jr. teaches that one large sheet of masking material should be applied to cover the whole masked area of a window pane.

Eckert teaches a method that allows people to spray paint the trim around a window, rather than painting the trim by hand. Eckert indicates that the existing methods of masking window panes and adjacent areas have been so time-consuming and tedious that much of the benefit of spray painting window trim has been lost, and that as a result it has not been customary to even attempt to spray paint window trim on houses, but rather brush painting of window trim has been commonly practiced (see Eckert, column 1, lines 8-17).

Eckert's method involves the following. First, the siding areas immediately surrounding a window (on the side of the house) are covered with swallowtail-cut strips

of masking paper, to provide a covering that extends about the area outside the window and its frame, leaving the exterior window frame 36 and the outside window sill 37 exposed for spray painting (see Eckert, column 2, line 60 – column 3, line 5). Next, each glass pane 38 is completely masked by a single masking sheet, preferably formed of heavy paper or cardboard (see Eckert Figure 6, and column 3 lines 7-17). Eckert teaches applying each masking sheet to the glass by making two small openings in the masking sheet, and applying two small pieces of pressure-sensitive adhesive tape over the openings in the masking sheet, so the adhesive tape holds the masking sheet on the glass. Thus, in Eckert, a single sheet of masking material covers the whole area of each pane. This is also the case in Adams Jr.

The final step of the Eckert method involves applying strips of masking paper over the projecting storm sash, which projects forwardly of the trim frame (see Eckert, column 3 lines 26-35, and Figure 4). The strips of masking paper have a swallowtail cut, so that the sides and corners of the three dimensional storm sash can be fully covered by bending the swallowtail ends of each strip over the sides and corners of the storm sash. Two swallowtail strips, overlapped end over end, are applied to cover each side of the storm sash (see Eckert, column 3 lines 26-35, and Figure 4). Thus, the strips of masking material in Eckert are only applied on the perimeter of the window, so as to cover the storm sash and a small peripheral area of the masked pane (which will have already been masked by a single sheet of masking material).

Even assuming *arguendo* that a *prima facie* case of obviousness exists, no combination of Adams Jr. and Eckert would achieve the features of amended claim 1. This claim requires a removable protective covering comprising a plurality of strips of

masking material that are disposed over a central portion of said first surface and that extend across a length of said first surface or across a width of said first surface. If one were to combine Adams Jr. and Eckert in the manner suggested by the Office Action, one would replace the single masking sheet in Eckert that covers the whole masked area of the glass (and is taught preferably to be heavy paper or cardboard) with the single piece of masking material in Adams Jr. that is applied over the whole masked area of the glass. The swallowtail strips would be applied to cover the irregularly-shaped area surrounding the window and its frame (on the siding of the house). The swallowtail strips would also be applied over the irregularly-shaped storm sash, with a small overlap at the perimeter of the already-masked glass. Therefore, in any such combination, there would not be a plurality of strips of masking material that are disposed over a central portion of the pane's first surface and that extend across a length of the pane's first surface or across a width of the pane's first surface, as claimed. Moreover, there would not be a plurality of overlapped strips of masking material each adhered to the surface of the pane by a masking adhesive. Rather, there would at best be a single piece of masking material adhered to the central area of the pane, with swallowtail strips covering the surrounding storm sash and overlapping a small perimeter area of the single masking sheet covering the pane. These swallowtail strips would be adhered to the single masking sheet already covering the pane, rather than to the pane itself.

Thus, Applicant considers that amended claim 1 and each claim depending therefrom are patentably distinct from any combination of Adams Jr. and Eckert. The rest of the cited art fails to provide any additional teaching that would render obvious the

invention of amended claim 1. Therefore, Applicant respectfully requests allowance of claim 1 and each claim depending therefrom.

The Office Action also rejected claims 48-51 and 53 under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Berg; rejected claims 48-51, 53, and 55 under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. in view of Smith and Emmanuel; and rejected claim 54 under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. in view of Smith and Emmanuel and further in view of Tachauer.

These claims involve a glazing assembly comprising a transparent pane and a frame to which the pane is mounted, glazing compound is positioned between the frame and the pane, and the pane has a protective covering comprising masking material that extends beneath a confronting surface of the frame but does not extend so far beneath the frame as to engage the glazing compound. Amended claims 48 and 56 recite "...the protective covering comprises *a plurality of strips* of masking material..." and "...the masking material is a *flexible* masking film...". These features would not be obvious over Smith in view of Berg, over Adams Jr. in view of Smith and Emmanuel, or over Adams Jr. in view of Smith and Emmanuel and further in view of Tachauer.

Consider the following with respect to the proposed combination of Smith in view of Berg. The Smith reference shows a window assembly for use in mass transit windows (train windows, bus windows, etc.) where a panel 14 is secured against a windowpane 12. The panel 14 is intended to prevent vandals from breaking or otherwise damaging the glass windows 12 in a train or bus, for example. As a result, the panel 14 in Smith is formed of a material that would protect against vandalism, such as acrylic or polycarbonate. These are materials that have historically been used for cockpit domes on

airplanes. In more detail, Smith teaches a windowpane 12, a *frame 20* surrounding the windowpane 12, a *seal 15* between the windowpane 12 and the frame 20, and a protective panel 14 secured against the windowpane 12.

The present claims involve masking film that is positioned to extend beneath the claimed frame. The Examiner characterizes the seal 15 in Smith as being the frame 20. Smith, however, specifies that element 20 is the frame (see e.g., col. 3, lines 32-34). The Examiner characterizes the panel 14 in Smith as being the claimed masking film. Applicant submits that the panel 14 in Smith is not fairly equated to being the claimed masking film. To further clarify the nature of the claimed masking film, however, this amendment specifies that the masking material in question is a flexible masking film.

Moreover, the present claims require a glazing assembly wherein a bead of glazing compound is between the pane and the frame, and the masking film is positioned to extend beneath the frame but not so far as to engage the glazing compound. The Office Action characterizes Smith's seal 15, which is taught preferably to be rubber or other similar material (see Smith, column 3, lines 51-53), as being the claimed frame. The Office Action then states that it would have been obvious to add glazing compound between the seal 15 and the pane 12 of Smith, given the disclosure in Berg of applying a sealing mastic between Berg's glass panes 11, 12 and the surfaces of Berg's framing members 15. Applicant respectfully disagrees. The sealing mastic would be needed in Berg to provide a seal with some give and ability for movement without breakage between the rigid glass panes 11, 12 and the rigid framing members 15, which are taught preferably to be aluminum (see Berg, column 2, lines 16-19). To the contrary, the rubber seal in Smith already serves this function, and provides a seal with give and the ability for

movement without breakage between Smith's pane 12 and Smith's actual frame 20.

Moreover, Applicant considers that if anything the nature of the seal 15 in Smith teaches away from any combination that would involve adding any sort of glazing material between the form-fitting seal 15 and the pane 12.

Further, the teachings of Smith make clear that any modification in which Smith's panel is replaced with the claimed plurality of strips of flexible masking film would not work for the intended purpose. For example, the claimed plurality of strips of flexible masking film could not be properly mounted in the manner shown by Smith. A plurality of strips of flexible masking film would not be properly supported by the seal assembly 15 taught in Smith. This can be appreciated in Figure 2 of Smith and the attendant teachings (see e.g., Smith column 4, lines 15-17), wherein a spacing segment 50 is wedged between the panel 14 and the windowpane 12 in order to create an air gap between the panel and the windowpane. If multiple strips of flexible masking film were mounted in this manner, the masking film would sag down under its own weight. Moreover, it would not be desirable to replace the single panel of Smith with a plurality of smaller panels, as the interfaces between adjacent panels would distort vision through the glazing assembly. This also would likely require redesign of the form-fitting seal 15 of Smith to the extent the multiple panels were overlapped. If the multiple panels were used in a side-to-side fashion, this would likely be less the protective, as vandals could potentially access the underlying window pane between adjacent panels. Therefore, Applicant submits that the nature of Smith's glazing assembly teaches away from any modification or combination that would involve replacing the panel in Smith with a plurality of strips of flexible masking film.

The present case is replete with evidence that it would not be obvious to modify Smith by replacing its panel 14 with a film. For example, any modification of this nature would destroy the intended function of the Smith assembly. It is well established that any modification that destroys the intended function of the modified apparatus cannot be obvious. In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). The claimed multiple strips flexible masking film would not be suitable for protecting against the vandalism for which the Smith system is designed. For example, vandals could simply pull overlapped strips of masking film off the pane. As noted above, Smith teaches a panel 14 of materials like acrylic or polycarbonate, which historically has been used for the cockpit domes on airplanes. This type of material would of course work well for a panel designed to prevent vandals from breaking or otherwise damaging the glass windowpanes in trains and buses. To the contrary, a plurality of strips of flexible masking film simply would not be chosen by skilled artisans for protection against vandalism. For example, multiple strips of flexible masking film could simply be peeled off the pane, and therefore could be easily removed by vandals. In view of the foregoing, Applicant submits that any modification or combination that would involve replacing the Smith's panel with a plurality of strips of flexible masking film would not be obvious.

Thus, Applicant submits that amended claims 48 and 56 and each claim depending therefrom define patentably over any combination of Smith in view of other prior art.

The Office Action has also rejected claims 48-51, 53, 54, and 55 under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. in view of various combinations of Smith, Emmanuel, and/or Tachauer. Consider the following with respect to the proposed

combinations involving Adams Jr. as the primary reference in view of Smith and Emmanuel.

Adams Jr. teaches applying a single sheet of masking material over the whole masked area of a pane. Adams Jr. teaches that the masking material should extend just up to the inner edge of the frame into which the masked pane will be mounted, but not beneath the frame. Thus, Adams Jr. teaches directly away from any modification, with any other secondary references, that would involve extending the single masking sheet of Adams Jr. beneath the frame. This is not surprising in that extending a single sheet of masking film beneath the frame in which the masked pane is mounted would result in all the peripheral edges of the masking film being concealed beneath the frame. This would make it particularly difficult to remove the masking film, and may necessitate removal with a knife or another thin rigid member, which would create a risk of scratching the window and/or the frame. The Office Action has proposed a combination of Adams Jr. in view of Tachauer. Applicant, however, considers there to be no motivation to combine these very different types of references, one involving masking film for windows, the other involving Velcro roofing technology. This is borne out in more detail below.

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. In re Fritch, 972 F. 2d 1260, 1265, 23 U.S.P.Q.2D (BNA) 1780, 1783 (Fed. Cir. 1992). The Examiner can satisfy this burden only by showing an objective teaching in the prior art or that knowledge generally available to one of ordinary skill the art would lead that individual to combine the relevant teachings of the references. Id. Combining prior art references without evidence of a suggestion, teaching, or motivation to combine

simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability, the essence of hindsight. In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2D 1614, 1617 (Fed. Cir. 1999); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 U.S.P.Q. (BNA) 543, 547 (Fed. Cir. 1985). The best defense against the subtle but powerful attraction of a hindsight based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999). There is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 U.S.P.Q. (BNA) 26, 31 (Fed. Cir. 1985). Further, broad conclusory statements regarding the teachings of multiple references, standing alone, are not evidence. McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 U.S.P.Q.2D (BNA) 1129, 1131 (Fed. Cir. 1993). Rather, the showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence. In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999); C.R. Bard, 157 F.3d 1340, 1352, 48 U.S.P.Q.2D (BNA) 1129, 1131 (Fed. Cir. 1993).

The Examiner has not established the necessary motivation to combine Adams Jr. and Tauchauer. The Examiner cites Adams Jr. as the primary reference here. Adams Jr. teaches a window pane that is covered with a single piece of masking material positioned to extend just to the inside edges of the frame in which the pane is installed. The Examiner acknowledges that Adams Jr. does not show a transparent pane covered with a plurality of masking strips. The Examiner resorts to Tachauer as a secondary reference.

Tachauer teaches methods for attaching the roofing and siding of buildings and other large membranes using a combination of hook and loop fasteners, staples, nails, and permanent adhesive. Applicant submits that no motivation fairly exists for combining these two fundamentally different references.

The Examiner states: "It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr.'s modified structure to show the protective covering having a plurality of strips of masking material because it would allow for the covering of large surfaces without resorting to one large piece of covering as taught by Tachauer et al, and thus resulting in cost saving per easy covering of the pane." Applicant submits that this is not a clear and particular showing of any motivation to combine these two references. Moreover, Applicant submits that, after a careful reading of the references, this statement is not supported by any actual evidence on the record. Tachauer does disclose roofing systems and other large membranes wherein shingles and other membranes are permanently attached in an overlapping manner. However, there is nothing to suggest the desirability of adopting such an overlapping pattern for covering windows with multiple strips of removable masking film.

Both Adams, Jr. and Applicant are concerned with masking windows, so it is difficult to see any motivation to combine based on a need "for covering large surfaces without resorting to one large piece of covering". The Examiner has connoted that somewhere in Tachauer there is found a suggestion that covering windows with multiple strips of window masking film would save money and be easier to carry out than covering a window with a single sheet of masking film. Applicant, however, considers that there is nothing in the record that provides any evidence supporting this connotation.

To the contrary, Applicant submits that no motivation fairly exists for combining these two very different references.

Finally, Tachauer itself contains objective evidence that the proposed combination is not obvious. For example, Tachauer details a myriad of embodiments wherein roofing, siding, and a host of other large membranes are applied to a building. Yet nowhere in Tachauer is there any mention of how the invention might be applied to windows. Moreover, Figure 14 of Tachauer actually illustrates a window in one of the walls of the building and there is no mention anywhere in Tachauer of covering the window in any way with the hook and loop membrane system of the invention. Thus, the Applicant submits that the Examiner has failed to establish the necessary motivation for any combination involving Adams Jr. and Taucher.

Applicant considers that the lack of a prima facie obviousness in this case is understandable given the fundamental differences between the Adams, Jr. and Tachauer references. The field of providing temporary window masking is very different from the field of providing permanent roofing, siding, and other large membranes. For example, the problems associated with temporary window masking are very different from those associated with roofing, siding, and other permanent membranes. Applicant's invention provides window masking that thoroughly covers the surface of a window and yet can be removed easily and completely from the window (e.g., by grasping one of an exposed lateral edge of the masking film and peeling the film off the window pane). First, it is noted that this problem is not solved by Adams, Jr., as the window pane there is neither thoroughly covered nor easy to remove. For example, the masking material on the window pane of Adams, Jr. extends right up to, or just short of, the inner edges of the

frame in which the window pane is mounted. As a result, the peripheral regions of the masking film do not extend at all beneath the frame, as is optionally done in some embodiments of the Applicant's invention to provide extra protection against dripping paint, silicone vapors, and other contaminants. Moreover, when a single sheet of masking film comes all the way, or almost all the way, to the inner edges of frame, one has to try to catch his fingernail or a small tool on the very outer edges of the sheet of masking material to remove the film. Because the outer edges of the masking film are so close to the inner edges of the frame, however, removal is not particularly convenient. Tachauer, of course, is not concerned with this removal problem whatsoever, as the roofing, siding, and other large membranes of Tachauer are of a more permanent nature.

Thus, Applicant submits that the fundamental differences between the fields of Adams, Jr. and Tachauer, as well as the considerably different problems with which these references are concerned, provide further evidence in the record that a person of ordinary skill in the art seeking to solve problems associated with temporary window masking would not reasonably be expected or motivated to look to the more permanent attachment systems of roofing, siding, and other large membranes. In order to rely on a reference as a basis for a rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. See In re Oetiker, 977 F.2d 1443, 1447 24 U.S.P.Q.2D (BNA) 1443, 1447 (Fed. Cir. 1992) (here, the references on which the Board relied were improperly combined, as it was not shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to hook and eye fasteners for garments). In sum, Applicant

respectfully submits that there is no motivation to combine the Adams Jr. and Tachauer references.

Remarks presented above also apply to new claims 61 and 62, which have been added to focus on certain preferred embodiments.

The foregoing amendments are being filed to expedite prosecution of the present application by pursuing prompt allowance of claims covering certain preferred embodiments. Applicant maintains that the original claims are patentably distinct over the cited art. The foregoing discussion, for example, highlights features that appear in the original claims and are patentably distinct from the cited art. Applicant expressly reserves the right to pursue the original claims in further prosecution.

Applicant submits that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested. The Examiner is invited to call the undersigned to discuss any questions or suggestions he may have on this application.

Respectfully submitted,

Dated: _____

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